

### Remarks

Claims 1-118 are pending.

Claims 1, 28, and 67 are being amended.

### Double Patenting Rejections

On page 2 the Examiner rejected claims 1 and 67 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 4 of U.S. Patent No. 7,366,761. Applicants are submitting with this Response and Amendment a terminal disclaimer and the appropriate fee as set forth in 37 C.F.R. §1.20(d). Applicants therefore respectfully request that the Examiner withdraw the double patenting rejection.

### Rejections under 35 U.S.C. §102(e)

On page 5 the Examiner rejected claims 1-27, 29-37, 39-44, 48-95, and 101-118 under 35 U.S.C. 102(e) as being anticipated by U.S. Published Patent Application No. 2003/0233418, by Phillip Y. Goldman (“*Goldman*”). In response, Applicants respectfully traverse and assert that claims 1-27, 29-37, 39-44, 48-95, and 101-118 are not anticipated by *Goldman*.

In order to anticipate a claim, a reference must teach all elements of a claim. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, the reference must show the claimed invention “in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). *See id.* Applicants will show that the cited reference fails to teach all elements of Applicants’ independent claims 1 and 67. Therefore, the claims are not anticipated and thus are novel.

Applicants are addressing arguments to independent claims 1 and 67 together because the Examiner has rejected independent claims 1 and 67 with the same arguments.

Goldman does not identify an “actual” sender

The Examiner stated on page 5 in paragraph 1 that “[r]egarding Claims 1 and 67, Goldman discloses . . . identifying *information about a sender* of the e-mail message . . . *including . . . an actual sender.*” (Emphasis added.) Applicants’ independent claim 1 recites, *inter alia*, “identifying *information about a sender* of the e-mail message *including . . . an actual sender.*” (Emphasis added.) Applicants’ independent claim 67 recites, *inter alia*, “*information about a sender* of an e-mail message . . . *includes . . . an actual sender.*” (Emphasis added.) Applicants’ independent claims 1 and 67 differentiate between the sender and an actual sender. Applicants’ specification in paragraph [0011] defines the “actual” sender where

data about the sender which is contained in the message is used to identify the *actual sender* by a signature either combining pieces of information from the message header or combining a range of IP addresses and information from the message header. Other ways of identifying the sender include using the final IP address used by the sender, the final domain name used by the sender, and/or the IP path used to send the message. (Emphasis added.)

Further, Applicants’ original claims 2, 3, 68, and 69 recite ways in which an “actual” sender may be identified.

In contrast, *Goldman* teaches “[i]n general, incoming electronic message . . . *may or may not include a sender’s address* 57.” (See *Goldman* at paragraph [0038]. Emphasis added.) Goldman also teaches

the term “sender’s address” refers to an address that accompanies an incoming electronic message and either actually identifies *or purports to identify* the sender. Many senders of unsolicited electronic messages send

*false addresses that do not correctly identify the sender. As used herein, addresses that accompany unsolicited electronic messages **represent** examples of “sender’s addresses” regardless of whether the addresses actually identify the sender. (See Goldman at paragraph [0046]. Emphasis added.)*

The “sender’s address” taught by *Goldman* is equivalent to Applicants’ “e-mail address used by the sender,” which as *Goldman* admits, may or may not identify the actual sender. Applicants’ identification of the “actual sender” only uses “an e-mail address used by the sender” as one of many criteria. *Goldman*’s teaching of the use of a sender’s address “regardless of whether the addresses actually identify the sender” is clearly not taking steps to improve the likelihood of identifying an *actual sender*. Thus, since *Goldman* does not teach “an actual sender,” *Goldman* does not teach all elements of Applicants’ independent claims 1 and 67.

Further, the Examiner stated on page 5 in paragraph 1 that “[r]egarding Claims 1 and 67, Goldman discloses . . . ***sending the information about the sender . . . compiling statistics based on the information about the sender.***” (Emphasis added.) In response, Applicants are amending independent claim 1 to insert “identified” in claim elements “c)” and “d)” as supported by claim element “b).” Applicants are similarly amending independent claim 67 to insert “collected” in claim element “a)” as supported by claim element “a)” and as originally appears in claim element “b).” Applicants are also amending independent claim 67 to insert “about the sender” in claim elements “a)” and “b)” as supported by claim element “a).” As the rejection might be applied to the claims as amended, Applicants respectfully traverse. Applicants will address “information about the sender” and “compiling statistics” separately.

*Goldman does not use “identified” or “collected” information*

As for *Goldman*’s “information about the sender,” Applicants’ amended independent claim 1 recites, *inter alia*,

identifying information about a sender of the e-mail message including at least one of the following . . . an actual sender. . . a final IP address used by the sender . . . a final domain name used by the sender . . . or . . . an IP path used by the sender . . . sending the *identified* information about the sender. (Emphasis added.)

Applicants' amended independent claim 67 recites, *inter alia*,

collecting information about a sender of an e-mail message, wherein the *collected* information about the sender includes at least one of the following . . . an actual sender . . . a final IP address used by the sender . . . a final domain name used by the sender . . . and . . . an IP path used by the sender. (Emphasis added.)

As for *Goldman's* alleged teaching of “*information about the sender*,” *Goldman* in contrast teaches “*filtering incoming electronic messages according to the sender's address*.” (See *Goldman* at paragraph [0008]. Emphasis added.) *Goldman* also in contrast teaches “the electronic messaging management application 11 provides a categorization module 26 that *categorizes sender's addresses as ‘authorized,’ ‘unauthorized,’ or ‘unconfirmed’* and modifies data structure 18 accordingly.” (See *Goldman* at paragraph [0040]. Emphasis added.) The “information about the sender” taught by *Goldman* is neither the “*the identified* information about the sender” recited in Applicants' independent claim 1 nor “*the collected* information about the sender” recited in Applicants' independent claim 67. This is because *Goldman* neither teaches “an actual sender,” as shown above, nor “a final IP address,” nor “a final domain name,” nor “an IP path.” The “information about the sender” as taught by *Goldman* is merely the “sender's address” which is placed in one of three categories: authorized, unauthorized, or unconfirmed. Plus, the sender's address, as admitted by *Goldman*, may not even be included in an e-mail message and if included may not identify the sender.

Thus, since “the information about the sender” as taught by *Goldman* does not include any of the *identified* or *collected* information items recited in Applicants' independent claims 1 and 67, neither “an actual sender,” nor “a final IP address,” nor “a final domain name,” nor “an IP

path,” *Goldman* does not teach all elements of Applicants’ amended independent claims 1 and 67.

*Goldman* does not compile statistics

As for *Goldman*’s alleged teaching of “***compiling statistics***,” Applicants’ amended independent claim 1 recites, *inter alia*, “***compiling statistics*** based on the identified information about the sender.” (Emphasis added.) Applicants’ amended independent claim 67 recites, *inter alia*, “***compiling statistics*** . . . about the sender based on the collected information about the sender.” (Emphasis added.)

*Goldman*, in contrast, teaches “data structure 18 that has fields in which ***sender’s addresses are categorized***. Each sender’s address is generally separated into one of three categories. The ‘authorized’ category. . . . The ‘unauthorized’ category. . . . The ‘unconfirmed category’.” (See *Goldman* at paragraph [0044]. Emphasis added.) *Goldman* further teaches that

[f]ilter module 24 ***compares a sender’s address*** associated with an incoming electronic message ***to the categorizations*** provided or stored in data structure 18 . . . If the sender’s address is located in the authorized category, the filter module 24 routes the incoming message to the user’s inbox 28. If the sender’s address is located in the unauthorized category, the filter module 24 routes the incoming message to the trash box 31. If the sender’s address is located in the unconfirmed category, the filter module 24 routes the incoming message to an unconfirmed folder 69. (See *Goldman* at paragraph [0049]. Emphasis added.)

Applicants will show that the categorization and comparing of sender’s addresses as taught by *Goldman* is not “compiling statistics.”

"[A] judge who encounters a claim term while reading a patent might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term." *Phillips v. AWH Corp.*, 415 F.3d 1303,1324 (Fed. Cir. 2005). Accordingly, definitions for the terms statistics, calculate, compare, and categorize appear below.

## Statistics

A Glossary of Statistics at

<http://linkage.rockefeller.edu/wli/glossary/stat.html#s> defines a statistic as “[a] **number** or code **derived by** a prior-defined consistent process of **calculation, from a set of data.**”

(Emphasis added.)

An on-line glossary of statistical terms, produced by the STEPS TLTP Project at

[http://www.stats.gla.ac.uk/steps/glossary/basic\\_definitions.html#stat](http://www.stats.gla.ac.uk/steps/glossary/basic_definitions.html#stat) defines a statistic as “a **quantity that is calculated from a sample of data.**” (Emphasis added.)

## Calculate

The on-line Merriam Webster Dictionary at

<http://www.merriam-webster.com/dictionary/calculate> defines calculate as “to **determine by mathematical processes.**”

(Emphasis added.)

The on-line Encarta Dictionary at

[http://encarta.msn.com/dictionary\\_/calculate.html](http://encarta.msn.com/dictionary_/calculate.html) defines calculate as to “**work something out mathematically.**”

(Emphasis added.)

## Compare

The on-line Merriam Webster Dictionary at

<http://www.merriam-webster.com/dictionary/compare> defines compare as “to **represent as similar.**” (Emphasis added.)

The on-line Encarta Dictionary at

[http://encarta.msn.com/dictionary\\_/compare.html](http://encarta.msn.com/dictionary_/compare.html) defines compare as to “**examine people or things for similarities.**”

(Emphasis added.)

## Categorize

The on-line Merriam Webster Dictionary at

<http://www.merriam-webster.com/dictionary/categorize> defines categorize as “to **put into a category : classify.**” (Emphasis added.)

The on-line Encarta Dictionary at

[http://encarta.msn.com/dictionary\\_/categorize.html](http://encarta.msn.com/dictionary_/categorize.html) defines categorize as to “put somebody or something into category: **to place somebody or something in a particular category and define or judge the person or thing accordingly.**” (Emphasis added.)

As for the alleged statistics of *Goldman*, *Goldman* teaches the storing of sender’s addresses into categories. Sender’s addresses are merely text strings. Sender’s addresses are not derived from a process of calculation from a sample or a set of data. *Goldman*’s categorization of sender’s addresses is merely a placement of the sender’s addresses into lists, not calculation requiring mathematical processes. A

sender's address is either in a category or not in a category. Further, *Goldman's* comparing is only determining into which of the three categories the sender's address has been placed.

Since *Goldman's* sender's addresses are not statistics and *Goldman* only teaches the use of a comparison and categories, which are neither calculating nor mathematical techniques, *Goldman* does not teach "***compiling statistics*** based on the identified information about the sender" as recited by Applicants' amended independent claim 1 or "***compiling statistics . . .*** about the sender based on the collected information about the sender" as recited by Applicants' amended independent claim 67. Therefore, *Goldman* once again fails to teach all elements of Applicants' independent claims 1 and 67.

In summary, Applicants have shown that *Goldman* teaches none of Applicants' independent claim 1 and 67 elements relating to 1) an actual sender, 2) identified or collected information about the sender, or 3) compiling statistics. *Goldman* therefore cannot and does not anticipate Applicants' independent claims 1 and 67, thus claims 1 and 67 are allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 1 and 67 under 35 U.S.C. §102(e). Moreover, since claims 1-27, 29-37, 39-44, and 48-66 depend either directly or indirectly from claim 1 and claims 68-95, and 101-118 depend either directly or indirectly from claim 67, they too are allowable for at least the same reasons.

#### Rejections under 35 U.S.C. §103(a)

On page 24 the Examiner rejected claim 38 under 35 U.S.C. §103(a) as being unpatentable over *Goldman*. Further, on page 25 the Examiner rejected claims 28, 45-47, and 96-100 under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Published Patent Application No. 2004/0139136 to Wallace *et al.* ("*Wallace*"). Applicants respectfully traverse. As shown above, independent claims 1 and 67 are novel and

allowable. Therefore, dependent claims 28, 38, 45-47, 58, and 96-100 are allowable for at least the same reasons.

Applicants therefore respectfully request that the Examiner withdraw the rejections to dependent claims 28, 38, 45-47, 58, and 96-100 under 35 U.S.C. §103(a).

## Conclusion

Applicants are filing a terminal disclaimer to obviate the double patenting rejection. Applicants show that independent claims 1 and 67 are not anticipated by the cited reference. Moreover, since claims 1-27, 29-37, 39-44, and 48-66 depend either directly or indirectly from claim 1 and claims 68-95, and 101-118 depend either directly or indirectly from claim 67, they too are allowable for at least the same reasons.

Reconsideration and a Notice of Allowance are requested.

The Examiner is invited to contact the undersigned with any comments or questions at 408-297-9733 between 9:00 AM and 5:00 PM PST.

### CERTIFICATE OF TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) on the date shown below.

Signed: 

Typed Name: Sally Azevedo

Date: \_\_\_\_\_ October 17, 2008 \_\_\_\_\_

Respectfully submitted,



Eppa Hite

Reg. No. 30,266

Schneck & Schneck

P.O. Box 2-E

San Jose, CA 95109-0005

(408) 297-9733